

Remarks

Applicants hereby add new claims 23-26. Accordingly, claims 1-26 are pending in the present application.

Claims 1-4, 7-12, 15-18, and 21-22 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No 4,167,322 to Yano et al. in view of U.S. Patent No 6,023,593 to Tomidokoro. Claims 5-6, 13-14, and 19-20 stand rejected under 35 USC 103(a) for obviousness over Yano et al. in view of Tomidokoro and further in view of U.S. Patent No. 6,108,099 to Ohtani.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to the prior art rejections, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8<sup>th</sup> ed.). As discussed below, there is no motivation to combine the reference teachings, and even if combined, the combination fails to disclose or suggest positively-recited limitations of the claims. The 103 rejections are improper for at least these reasons as further discussed below.

Claim 1 recites processing circuitry configured to replace an initial variable with another variable configured to control the formation of another of the consumable order assist functions. Teachings of Yano have been identified as allegedly disclosing the claimed processing circuitry. In particular, on page 3 of the Action, it is alleged that selective viewing of only certain parameters or even only one parameter at a time of col. 4, lines 4-19 via a keyboard *suggests* replacement of the claimed initial variable with another variable. Applicants respectfully disagree.

The teachings in col. 4 relied upon as allegedly disclosing the claimed replacement provide that the *size of the display may be reduced to save cost even though only one or certain parameters may be displayed at one time* and the parameter displayed may be selected. Such teachings only teach different modes

of display which may be controlled responsive to user input via a keyboard and selection of a parameter. *These teachings are absolutely irrelevant to any replacement of a variable with another variable.* In addition, the claimed initial and replacement variables are positively claimed to control the formulation of respective initial and another consumable order assist functions. Any teachings concerned with controlling a mode of display or selection of a parameter by a user *fail to disclose or suggest any teachings regarding the claimed replacement of variables configured to control formulation of respective order assist functions.* The identified teachings of Yano refer to selection and can not be fairly interpreted to disclose the claimed replacement as baldly alleged in the Action. Further, the alleged suggestion of the replacement of the variable based upon the teachings of col. 4 set forth on page 3 of the Action is non-sensical in view of the statement of page 3 of the Action that the storage circuitry and processing circuitry of Yano are not configured to store, process or communicate a variable.

Tomidokoro fails to cure the deficiencies of Yano. There are no teachings in Tomidokoro of replacement of a variable. As set forth in the Office Action, copiers of Tomidokoro take an action responsive to reception of a properly addressed polling signal per the teachings of col. 6. There is no teaching nor suggestion of replacing a variable configured to control the formation of an initial consumable order assist function with another variable configured to control the formation of another function. The function of Tomidokoro is the same responsive to reception of the polling signal and no replacement is taught nor suggested. Accordingly, even if the prior art teachings are combined, the combination fails to disclose or suggest limitations of claim 1 including the claimed replacement of the specifically-defined variable and claim 1 is allowable for at least this reason.

Applicants hereby request identification of prior art which discloses claimed limitations not found in the references of record or the submission of an affidavit in support of any rejection of the claims in *a non-final Action.* "[A]ssertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work" and "allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported." *In re Ahlert*, 424 F.2d 1088, 165 USPQ 418, 420-421 (CCPA 1970).

The Action fails to identify any teachings of the prior art which allegedly

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disclosure or suggest the claimed *processing circuitry configured to formulate another consumable order assist function responsive to the reception of a signal from a sensor configured to monitor a status of an imaging consumable* as claimed. The sensor of Yano merely monitors the consumable level for providing status information of the consumable life. Yano at col. 4, lines 67-69 state that depression of suitable keys causes data signals to be fed as opposed to outputting as a result of output from a sensor. Even if combined, Tomidokoro provides outputting a consumable item request responsive to the polling signal not the output of a sensor as claimed. The prior art fails to disclose or suggest this limitation and claim 1 is allowable for at least this reason.

In addition, the combination of the teachings of Tomidokoro with the teachings of Yano is improper and the 103 rejection of claim 1 is improper for at least this additional reason. As mentioned on page 3 of the Office Action, Yano is not concerned with communicating orders for toner. Thereafter on page 4, it is baldly alleged that the combination is appropriate to enable a copying machine to create and transmit a consumable request. The Action merely states that the combination can be made and is therefore appropriate. However, the mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. MPEP §2143.01 *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). However, there is no motivation presented in the Action and the rejection is improper for at least this reason.

Further, Yano is related to monitoring and control by one copier of other copiers. Yano provides that a user can monitor status of the copiers at col. 6, lines 14-20. Tomidokoro is directed to an extensive system external of the copier group 100 which orders consumables as opposed to the copiers themselves of group 100. Any combination of teachings of Tomidokoro regarding the external system with the copiers of Yano would require significant modification which would change the principle of operation of the system of Yano including the copier group. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP §2143.01 (8<sup>th</sup> Edition) *citing In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA

1959) (reversing a rejection wherein the suggested combination of references would require a change in the basic principle under which the construction was designed to operate.) 270 F.2d at 813, 123 USPQ at 352. The combination of reference teachings is inappropriate for at least these reasons and claim 1 is allowable.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 5, the Examiner relies upon the teachings of Ohtani as allegedly disclosing limitations of claim 5. However, the teachings of Ohtani are inapplicable to the teachings of Tomidokoro and the 103 rejection is improper for at least this reason. More specifically, as set forth in cols. 6-7 of Tomidokoro, data communication apparatus 200 polls individual copiers 100, compiles a list of the consumables needed, and thereafter sends the data to central controlling device 400 as set forth in col. 7, lines 45-60. At col. 13, central controlling device 400 orders the consumable from consumable item supplier 500. Accordingly, Tomidokoro already provides a system for ordering a consumable from a supplier 500 associated with device 400. It follows that Tomidokoro does not disclose and has no need for processing circuitry of the image forming device to formulate the consumable order assist function to include an identifier of a supplier of the consumable in view of the arrangement of device 400 ordering from existing supplier 500. There is no motivation or need to look to Ohtani to modify the already explicit teachings of Tomidokoro and the 103 rejection is improper for at least this reason. In view of the disparate reference teachings, the motivation for forming a combination of references or modification thereof only improperly results from hindsight reconstruction based on using the Applicant's invention as a road map for such a combination or modification. See, for example, *Interconnect Planning Corp. vs. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). Claim 5 is allowable for this additional reason.

In sum, the alleged motivation on page 11 of the Action is faulty and/or deficient to support a proper prima facie 103 rejection. More specifically, Tomidokoro already provides a system and method for ordering a consumable from

supplier 500. Accordingly, there is no need for a copier to store an identifier of a supplier as alleged in the Action. Further, the combination would change the basic principle under which the construction of Yano was designed to operate. There is no motivation to combine the reference teachings and the rejection of claim 5 is improper.

Referring to claim 6, the combination is inappropriate in view of the Tomidokoro teachings providing central controlling device 400 ordering from existing consumable item supplier 500. Apart from Applicants' disclosure, there is no need or motivation to modify Tomidokoro to provide processing circuitry of an image forming device configured to formulate the another consumable order assist function comprising an identifier of the purchaser of the imaging consumable as claimed. Claim 6 is allowable for at least this reason.

Further, the alleged motivation recited on page 12 of the Action is contrary to the explicit reference teachings. Tomidokoro already provides device 400 configured to place orders from supplier 500. In view of the system management teachings of device 400 of Tomidokoro, there is no need or motivation for processing circuitry of a copier to include an identifier of a purchaser of a consumable in consumable order assist function as claimed. Claim 6 is allowable for this additional reason.

Referring to claim 8, the image forming device is configured to replace an initial variable configured to control the formation of an initial one of plural consumable order assist functions with another variable to control the formation of another consumable order assist function. The keyboard of Yano to indicate parameters to be displayed and selective view provides absolutely no teaching or suggestion of replacement of a variable or replacement of a variable configured to control formulation of a consumable order assist function. Even if the references are combined, the combination fails to disclose or suggest positively-recited limitations of claim 8 and claim 8 is allowable for at least this reason.

In addition, claim 8 defines the host device configured to provide the another variable to the image forming device. The misplaced reliance upon the keyboard teachings of Yano may in no fair interpretation be considered to disclose or suggest the claimed host device separate from the image forming device or the host device configured to provide the another variable to the image forming device as claimed.

Claim 8 is allowable for at least this reason.

Tomidokoro discloses communication of needed consumables from a copier responsive to a polling signal. There is no disclosure or suggestion of the image forming device configured to control formulation of a consumable order assist function responsive to the detection of a predetermined status of an imaging consumable as claimed. Claim 8 recites numerous limitations not taught nor suggested by the prior art and claim 8 is allowable for at least this reason.

In addition, there is no motivation to combine the reference teachings and claim 8 is allowable for this additional reason.

The claims which depend from independent claim 8 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 16, even if combined, the combination fails to disclose or suggest *replacing an initial variable with another variable within the image forming device to control the formation of another of the consumable order assist functions* as claimed. Using a keyboard to control parameters to be displayed does not teach or suggest the claimed replacing. The rejection of claim 16 is improper for at least this reason.

In view of the Tomidokoro teachings of communicating responsive to the polling signal, there is no disclosure or suggestion of *generating the another one of the consumable order assist functions responsive to the detecting and the replacing* as claimed. Numerous limitations of claim 16 are not shown nor suggested by the prior art and claim 16 is allowable for at least this reason.

In addition, there is no motivation to combine the reference teachings. The combination would change the basic principle under which the construction of Yano was designed to operate. Claim 16 is allowable for this additional reason.

The claims which depend from independent claim 16 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a*

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*non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if any claims are not found to be allowable.

Applicants amend the specification to correct the indicated informality. Entry of the amendment is respectfully requested.

Applicants hereby add new claims 23-26 which are supported at least by Figs. 2-4 and associated specification teachings of the originally-filed application.


Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

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**STATEMENT OF RELEVANCE**

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Chinese Patent No. 1206154A is submitted herewith responsive to citation by the China Patent Office during the prosecution of a Chinese application related to U.S. Patent Application Serial No. 09/710,367. Applicant also includes a translated copy of an Office Action concerning the Chinese patent. U.S. Patent No. 5,862,404 is a related family member of China Patent No. CN1206154A.